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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,118

09/13/2007

Renji Maki

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05/14/2010

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EXAMINER

MACARTHUR, VICTOR L

ART UNIT

PAPER NUMBER

3679

MAIL DATE

DELIVERY MODE

05/14/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,118	Applicant(s) MAKI ET AL.	
	Examiner VICTOR MACARTHUR	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/31/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, claims 1-14, in the reply filed on 1/5/2010 is acknowledged.

Claim 15-18 have been canceled by applicant and thus withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/5/2010.

Drawings

The drawings are objected to for the following:

- Solid black shading not permitted. See 37 CFR 1.84(m).
- Reference to WO 2005/068853 and PCT/US2004/009495 in margins is improper.

Corrected drawing sheets in compliance with 37 CFR 1.84 and 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of

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the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to since reference to WO 2005/068853 and PCT/US2004/009495 in margins is improper.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-7 and 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "said central axis" (line 2 of claim 3) lacks proper antecedent basis.

The term "narrowed" (line 1 of claim 4) is a relative term and thus unclear without some frame of reference, i.e., "narrowed" with respect to what other element? Claims 5 and 10 are similarly phrased and thus also rejected.

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The term “inclined” (line 2 of claim 9) is a relative term and thus unclear without some frame of reference, i.e., “inclined” with respect to what other element?

The term “increased elevation portion” (line 2 of claims 13 and 14) are relative and thus unclear without some frame of reference, i.e., “increased elevation” with respect to what other element?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Maki USPN 5195793.

The prior art discloses (fig.5) applicant’s claimed clip structure to include a base (132, 133) having a top and bottom portion; a male member (131) extending outwardly from said top portion of said base, raised surface portions (raised side surfaces of 131) formed on opposing sides of said male member with a gap (gap between top 132 and sides of 131, shown receiving 12 in fig.4) being defined between said raised portions and said top of said base, a first attachment channel (receiving left 151c) formed in said base, a second attachment channel (receiving right 151c) formed in said base; said first and second attachment channels being in generally parallel relation to each other in said base and separated by a common wall (wall

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portion separating channels) extending between said top and said bottom portions of said base, said first and second attachment channels having elongated openings (left and right side openings), said elongated openings in said first and second attachment channels facing in opposing directions.

Regarding claim 2, note figure 5 embodiment shows eccentric limitation.

Regarding claim 9, note clip house (15).

As detailed above, the prior art structure is substantially identical to the claimed structure such that the PTO must presume claimed functions/properties (“for attaching a trim part”, “for snug receipt”, etc.) to be inherently capable thereof, thus presenting a *prima facie* case and properly shifting the burden to prove otherwise with evidence to the applicant. It is fairly the applicant's burden to obtain and test the prior art since the Patent Office is unable to manufacture or obtain prior art products. Mere allegation that the prior art does not inherently possess capability to perform applicant's claimed functions/properties is not sufficient without actual evidence proving as much. The MPEP sections and case law below clearly set forth that product claims are limited by structure and that functional limitations only limit a claim in so far as they require further specific structure. One cannot obtain patentability for a product structure by merely reciting an intended functional use thereof; at least not without testing structurally similar prior art structures and providing evidence proving incapability of such intended functional use thereof. The burden of such testing lies fairly with the applicant since it is applicant, not the PTO, who is endeavored in the making and using of products. Note the following:

- MPEP §2112.01 (I) states “When the structure recited in the reference is substantially identical to that of the claims, claimed properties or functions are

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- presumed to be inherent... [and] a *prima facie* case of either anticipation or obviousness has been established” (emphasis added);
- MPEP §2114 states “Apparatus claims must be structurally distinguishable from the prior art... [and the] Manner of operating the device does not differentiate apparatus claim from the prior art... [and a] claim containing a ‘recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus’ if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)” (emphasis in original).
 - “Where, as here, the **claimed** and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. See *In re Ludke, supra*. Whether the rejection is based on ‘Inherency’ under 35 USC 102, on ‘*prima facie* obviousness’ under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products. See *In re Brown*, 59 CCPA 1036, 459 F.2d 531, 173 USPQ 685 (1972)” (emphasis added) *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977);
 - “Apparatus must be distinguished from the prior art in terms of structure rather than function.” *In re Schreiber*, 128 F.3d 1473, 1477-78 44 USPQ2d 1429, 1431-32 (Fed.Cir.1997)

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- “Apparatus claims cover what a device is, not what a device does.” See *Hewlett-Packard Co. v. Bausch & Long Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)
- “[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.” (emphasis added) *In re Swinehart*, 58 CCPA --, --F.2d --, 169 USPQ 226 (1971), and *In re Ludtke*, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971);
- “[I]t is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.” (emphasis added) *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972);

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- "Contrary to appellant's reasoning, after the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to appellant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on... Here, appellant's burden before the board was to prove that Donley's structure does not perform the so-called method defined in the claims when placed in ambient light. Appellant did not satisfy that burden, it did not suffice merely to assert that Donley does not inherently achieve enhanced color through interference effects, challenging the PTO to prove the contrary by experiment or otherwise. The PTO is not equipped to perform such tasks." *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986);
- "Spada was reasonably required to show that his polymer compositions are different from those described by Smith. This burden was not met by simply including the assertedly different properties in the claims. When the claimed compositions are not novel they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in the prior art." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).
- MPEP §716.01(c)(II) states "The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965)."

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Conclusion

The prior art made of record on the attached PTO-892 form (if any) and not relied upon in the rejections above is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085.

The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

May 13, 2010

/Victor MacArthur/
Primary Examiner, Art Unit 3679